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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

019B.0024.U1(US)

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on June 9, 2011

Signature

Typed or printed
nameGail Conway

Application Number

10/030,798

Filed

May 9, 2002

First Named Inventor

Salonaho et al.

Art Unit

2618

Examiner

Dean, Raymond S.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒ attorney or agent of record.Registration number 54,106☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

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June 9, 2011

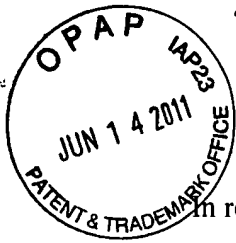
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE U.S. PATENT AND TRADEMARK OFFICE

In re U.S. Patent Application of:

APPLICANT: Salonaho, et al.
SERIAL NO.: 10/030,798 FILING DATE: May 09, 2002
EXAMINER: Dean, Raymond S. ART UNIT: 2618
ATTORNEY'S DOCKET NO.: 019B.0024.U1(US)
CONFIRMATION NO.: 5614
TITLE: A METHOD OF SELECTING A NEW CELL

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

This Pre-appeal Brief Conference Request is submitted with a Notice of Appeal in response to a Final Office Action (FOA) of March 11, 2011 in which claims 1-3, 5-9, 12-29, 31-37, 54, 64, 76, 89, 102, 117, 133, 150, 163, 164, 173, and 175-178 were rejected under 35 U.S.C. 103(a).

Claims 1-3, 7-9, 12-22, 29, 33, 54, 64, 76, 89, 102, 117, 133, 150, 163, 164, 173, and 175-178 are rejected under 35 U.S.C. §103(a) as being unpatentable over Charbonnier, U.S. Patent No. 5,241,686, in view of Periyalar, U.S. Patent No. 6,018,662, and further in view of Sundelin, U.S. Patent No. 6,144,861.

Claims 5, 6, 23, 24, 31, 32, and 35-37 are rejected under 35 U.S.C. §103 as being unpatentable over Charbonnier, in view of Periyalar and Sundelin, as applied to claim 1 above, and further in view of Karlsson, U.S. Patent No. 5,640,677.

The Applicant is of opinion that the Examiner's arguments in the Final Office Action of March 11, 2011 are inaccurate. The arguments made in the Applicants Response to Office Action received by the USPTO on December 20, 2010 are fully applied and incorporated here by reference. Additionally, the Applicant would like to make the following comments with respect to the Examiners comments in the Final Office Action of of March 11, 2011 in reference to Periyalar and Sundelin.

As far as Periyalwar is concerned, this reference teaches that on the basis of signal strength measurements, the mobile unit maintains a list of, e.g., active sets/candidate sets with reference to base stations. However the criteria for determining which base station to use is simply whether the *"pilot strength measurements... determines that the pilot is sufficiently strong"*, see column 5, lines 4 to 6 of Periyalwar. For the purpose of selection there is **no modification** in Periyalwar and the Examiner seems to not contend this.

As far as Sundelin is concerned, in the FOA of of March 11, 2011 in Section 3, the Examiner refers repeatedly to the abstract of Sundelin (e.g., see pages 7, 8, 13, 19, 22 of the FOA of of March 11, 2011). However, the long and lengthy features listed by the Examiner cannot be found by the Applicant in the Abstract of Sundelin. In this respect the Applicant invites the Examiner to state exactly where such text can be found in the Abstract of Sundelin.

As far as the Examiner's response to arguments are concerned, in **comment 1.a)** on pages 2-3 of the FOA it is stated in column 6, lines 39-42 of Sundelin that *mobile station compares the detected SIR with an SIR reference, and the difference is used to determine the value of the TPC command centre uplink.* It is further stated in column 6, lines 42-44 of Sundelin that *based upon the SIR measurements of the diversity combined signals the controller generates transmit power control commands.*

First, SIR is a **signal to interference ratio** and not a **signal strength of the cells** as recited in the current claims of the present patent application. Even if the parameter SIR could be equated to the signal strength, there are further differences, as explained below.

For example, in Sundelin the detected SIR is compared with a SIR reference. Therefore the comparison step is not comparing measurements of any parameter between a mobile station and two base stations but between a reference and a base station. Sundelin merely looks at differences between the SIR from a particular base station and a standard reference SIR. There is no relative comparison between several base stations.

Furthermore the result of the process in Sundelin is entirely different as it relates to and is for the purpose of controlling **downlink power**. Please note again that in Sundelin *mobile station compares the detected SIR with an SIR reference, and the difference is used to determine the value of the TPC command centre uplink,* as stated in column 6, lines 39-42 of Sundelin. Therefore as mentioned previously, it is clear that Sundelin does not relate to an aspect of the current claims that is **selection of a base station from a plurality of possible base stations**. It is predominantly, as it is stated in the Abstract of Sundelin, to control the *"transmit power of a base station transmission to a mobile station"*.

Although Sundelin does refer to soft handover, it does not do this in respect to or mention any detail of selection of a base station. This is merely incidental and peripheral. As stated by the Examiner, in Sundelin, the SIR of the cells are modified via the power control, however again this is modifying the actual signal. It is totally different from the current claim context where modifying is a prerequisite step for the comparison, and is performed on measurements and not actual signals. There is absolutely no evidence in Sundelin that there is any **comparison of modified signals, and furthermore modified signals in relation to different base stations**. Modification in Sundelin is actual modification of power rather than a modification for the purpose of a subsequent comparison and then selection steps.

As far as the Examiner's comments 1.b) on page 3 of the FOA, it might be true that there will be periodic comparison between current and other cells in an active set. However, this is totally separate from not only the methodology but also the purpose set out in the Examiner's comments with respect to measuring strength in the comment 1.a).

Furthermore, from the subject matter of the current claims it is clear that the comparison step occurs **after** the modifying step. It is to completely clear that any modifying step in Sundelin is **the final/end step**.

Representative claim (e.g., claim 1) of the present patent application recites the following:

“1. (Previously Presented) A method comprising:
measuring at a station a strength of a communication from a current cell;
measuring at the station the strength of a communication from at least one other cell;
modifying a result of measuring in which the strength of the communication from the at least one other cell and/or the current cell is measured to take into account a condition of said current and/or said at least one other cell if the measured strength of the communication from the at least one other cell satisfies a predetermined condition;
if modifying is performed, comparing the measured strength of the communication from the current cell and the measured strength of the communication from the at least one other cell being modified in the modifying; and
depending on results from the comparison, changing the current cell with which the station is associated, wherein said predetermined condition is that the strength of the communication from at least one other cell is greater than a threshold.”

It is also clear from the subject matter recited in the independent claims of the present patent application, that it is a measurement that is modified and further for comparison purposes whereas modification in Sundelin is a modification not of the measurement but of an

actual omitted SIR parameter. There is only a scant reference to handover and this is incidental to the description of Sundelin and unconnected with modification and measurement. As such the Applicant has difficulty in finding any relevance of Sundelin to the current claims.

The Applicant appreciates the Examiner's comments regarding the threshold for obviousness (inventive step). However, the skilled person would have to have **reasons why he would (and not just may) combine the particular features** from all the prior art to arrive at the claimed invention.

The purpose of the methodology of the current claims is to select a base station. The purpose of Sundelin is to control base station transmit power. Sundelin refers to soft handover, involving two or more base stations, it states that each of these base stations determines an SIR value. Sundelin further states in Abstract that *"each of the base stations controls its respective power"*. Thus although it refers to handover, this is not the purpose of either the Sundelin teaching or the purpose and reason for any measured SIR value. In other words there is no reference at all in Sundelin as to selection of a particular base station amongst the plurality of the base stations based on any measurement or comparison results as mentioned previously. As such the skilled person would **clearly not consider Sundelin even if he was aware of its teachings** when it comes to the primary purpose of selecting the most appropriate base station. As mentioned, it is difficult to see any relevance of Sundelin.

Again with reference to Charbonnier, this document has the purpose of regulation of traffic load of base stations (see title), and as the Abstract of Charbonnier states that *the process aims to constantly optimise the **distribution** of the load on a radio communication network relays*. It does this by measurements and correction parameters. However, since the purpose of Charbonnier is different from the subject matter recited in claims of the present patent application, even if the skilled person were aware of the contents of Charbonnier, he would not consider any teaching relevant to the fundamental purpose of the current claims.

As far as selection of the base station is concerned, the only relevance to the current claims in Periyalwar is the teaching that on the basis of signal strength measurements the mobile maintains list of pilot sets, active set, candidate set, etc. However, there is no hint (and the Examiner seems to agree) of any **modification** and also of any subsequent **comparison of modification** in the teaching of Periyalwar. Thus, the skilled person starting from Periyalwar wishing to improve on the teaching therein, would firstly not look to any teachings of Charbonnier or Sundelin even if he was aware of their contents, as any steps taught therein are for different purposes and performed in a different way. Therefore, any selection and incorporation

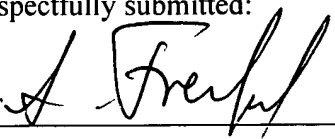
of features of the current claims from portions of Periyalwar, Sundelin and Charbonnier is highly contrived.

Furthermore, the modification in Sundelin is to a different parameter, and there is no subsequent comparison after modification, so even being shown this portion of Sundelin the skilled person would not arrive at the subject matter of the current claims.

Even any combined selected teachings from the three references of Periyalwar, Sundelin and Charbonnier cited by the Examiner still does not disclose or hint at modifying the "measured" signals of signal strength before a comparison step, and in particular for the purpose of selecting a base station.

The objections and rejections of the Final Office Action of March 11, 2011 having been shown to be inapplicable, withdrawal thereof is requested and passage of all claims to issue is earnestly solicited.

Respectfully submitted:



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Reg. No.: 54,106

6/9/2011
Date

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6/9/2011

Date

Matt Murray
Name of Person Making Deposit